

REMARKS/ARGUMENTS

Claim 1-39 are pending in the application and have been rejected.

**Double Patenting Rejection**

Claims 1-3, 8, 10-22, 24-26 and 30 stand rejected on the grounds of nonstatutory obvious type double patenting as being unpatentable over claims 1, 7 and 17 of U.S. Patent 6,470,216 (the '216 patent). Applicant respectfully traverses this rejection. However, in order to expedite prosecution and without acquiescing to the propriety of the rejection, Applicant has amended independent claims 1 and 30 to overcome the rejection. Independent claims 1 and 30 now recite "pre-positioning tissue at the tissue cite into an aesthetically corrected configuration." Claims 1, 7 and 17 of the '216 patent do not recite such a limitation. Accordingly, withdrawal of the rejection is respectfully requested. Also, claim 30 recites additional limitations not found in claims 1, 7 and 17 of the '216 patent. Accordingly withdrawal of the rejection of claim 30 is respectfully requested on this separate and additional basis.

**Rejections under 35 U.S.C. § 102**

Claims 1-39 are rejected under 35 U.S.C. 102(a) as being anticipated by Knowlton U.S. 6,359,993 (the '276 patent). The rejection is traversed in part and overcome in part.

First, with regard to claims 4-7, 31 and 35 and 36, the office action has contended that the '276 patent provides teaching of a plurality of lesions (continuous or partially overlapping) and delivering energy in a selected pattern (see office action at page 3). However a careful review of the sections the Examiner points to reveals no such teaching. While the section mentions various temporal modes of energy delivery, no where does the section or any part of the '276 patent for that matter, teach or suggest the delivery of energy in a selected spatial pattern or the production of a plurality of adhesions or lesions overlapping or otherwise. Applicant respectfully points out that for a reference to be anticipating, "[t]he identical invention must be shown [in the reference] in as complete detail as is contained in the ... claim."

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Here, none of the figures of the '276 patent show any patterns of energy deliver or a plurality of adhesions or lesions (overlapping or otherwise), nor are they described in the '276 patent specification. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 4-7, 31 and 35 and 36 on this basis alone.

Also, while the Examiner may contend that such teaching is inherent, Applicant respectfully points out that the courts have definitively held that inherency requires that skilled artisan deem a property or element to be "necessarily present" and not merely possible or even probable. See Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268-1269 (Fed. Cir. 1991). Applicant submits that the skilled artisan would not deem the teaching of a pattern of energy applications or the production of a plurality of over-lapping adhesions to be necessarily present in the teachings of the '276 patent as is required for inherency to be found. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 4-7, 31 and 35 and 36 on this separate and additional basis.

Applicant also notes that the office action provides no pertinent reasons for the rejection of independent claim 38. (The reasoning on page 4 of the office action is not understood because the Examiner refers to limitations not recited in claim 38). Claim 38 recites, "delivering a pattern of energy applications to the tissue site using an energy delivery device" and "remodeling at least a portion of tissue at the tissue site utilizing the pattern of energy applications." As discussed above, the '276 patent provides no teaching of delivering a pattern of energy applications and therefore does not even contemplate remodeling at least a portion of tissue at the tissue site utilizing the pattern of energy applications. Accordingly, withdrawal of the rejection of claim 38 is respectfully requested on this separate and additional basis.

With regard to independent claims 1, 30 and 39, Applicant traverses these rejection as well. Nowhere does Knowlton '276 even mention the word "adhesion", let alone producing a thermal adhesion or remodeling tissue at the tissue site utilizing a thermal adhesion. However, in order to expedite prosecution and without acquiescing to the propriety of the Examiner's rejections, Applicant has amended independent claims 1, 30 and 39 to overcome the rejections with regard to claims 1-30 and 39. Claims 1, 30 and 39 now recite "pre-positioning

tissue at the tissue cite into an aesthetically corrected configuration.” Support for this amendment is found throughout the application as filed; no new matter has been added. See the Specification, e.g., at page 61, line 11-22; page 65, line 14-18 and page 70, line 18-26. No where does the ‘276 patent teach or suggest such a limitation. The ‘276 patent never even mentions the words “tissue positioning”, “pre-positioning” or any positioning of tissue. Applicant also respectfully submits that the skilled artisan would also not deem such teaching to be necessarily present in the ‘276 patent to meet the inherency requirement of Continental Can Co. Accordingly withdrawal of the rejection is respectfully requested.

Additionally, claim 1 has been amended to recite “producing a thermal adhesion or lesion at the tissue site to secure tissue in the aesthetically corrected configuration.” No where does Knowlton ‘276 provide any teaching of utilizing a thermal adhesion to secure tissue in an aesthetically corrected configuration, nor can it since, as describes above, Knowlton provides no teaching of pre-positioning tissue into an aesthetically corrected configuration or otherwise.

Additional amendments of several claims have also been made to further distinguish Applicant’s invention. Dependant claim 2 has been amended to recite that tissue is pre-positioned prior to contact of tissue by the energy deliver device. Dependant claim 3 has been amended to recite that tissue is pre-positioned by dependant positioning of the patient or patient extremity. Dependant claim 14 has been amended to recite that pre-positioning is done using a skin tensioning device separate from the energy delivery device to apply force in a substantially parallel direction to the skin surface. Independent claim 30 and dependant claims 12, 13 and 25 have amended to recite specific values for the magnitude of force applied to the tissue site. Support for these amendments is found in the Application as filed; no new matter has been added. See the Specification, e.g., at page 63, line 27- 29, page 64, line 8-18 and page 65, line 3-10. No where does the ‘276 patent teach or suggestion any of these limitations. Accordingly, dependant claims 2, 3, 12-14 and 25 and independent claim 30 are considered independently patentable on these separate and additional bases and withdrawal of the rejection is therefore respectfully requested.

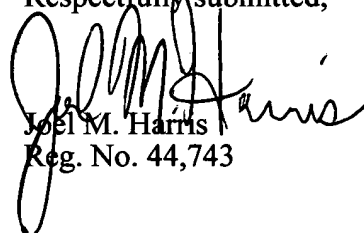
**CONCLUSION**

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-941-9421.

It is believed that no other fees time are due with this response; however, should any fees be required under 37 C.F.R. §§ 1.16 to 1.21 for any reason, Applicant respectfully requests the Examiner to contact the undersigned at the phone number indicated below so that payment can be provided. If any further extensions of time are required, Applicant respectfully petitions that such extensions be granted at this time.

Respectfully submitted,

  
Joel M. Harris  
Reg. No. 44,743